

REMARKS

The Office Action mailed May 10, 2004 has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

Drawings

The drawing figures have been corrected in accordance with the Examiner's suggestions. Specifically, FIG. 1 has been amended to include the caption "Prior Art." No new matter has been introduced. Approval of the corrections is respectfully requested.

Specification

The specification has been amended in order to address the objections raised in the Office Action and correct minor typographical and other errors.

Rejection(s) Under 35 U.S.C. § 112, First Paragraph

Claims 1 – 32 were rejected under 35 U.S.C. § 112, first paragraph, as based on a single means claim.

Claim 1, from which Claims 2 – 32 depend, has been amended to recite more than one means and thereby overcome the above rejection.

Rejection(s) Under 35 U.S.C. § 102 Rejection

Claims 1 – 16, 22, 29 and 32 – 34 were rejected under 35 U.S.C. § 102(b) as anticipated by Doshi et al.. Applicants respectfully disagree.

As can be understood from the recitations of independent Claims 1 and 33, the present invention transports all the overheads of a client signal including an overhead for a physical layer transparently. Through this feature, as explained for example on page 9, third paragraph, of the specification, low speed digital signals can be synchronized to apply time division multiplexing without using an overhead associated with a client signal.

In contrast, *Doshi et al.* transports signals of higher layers above an IP packet layer (i.e., third layer) transparently. That is, *Doshi et al.* merely discloses so-called "payload transparency". Thus, the above-described advantageous effect according to the present invention cannot be obtained from *Doshi et al.*

Specifically, *Doshi et al.* also fails to disclose or suggest a feature of the present invention that applies time division multiplexing to the whole of the client signal including the client overhead transparently. In this connection, the reference in the Office Action to page 138, left column, second paragraph, of *Doshi et al.* merely discloses payload transparency. *Doshi et al.* makes no mention to the transparency of an overhead. Thus, it is obvious that *Doshi et al.* fails to disclose or suggest this feature of the present invention.

Doshi et al. also fails to disclose or suggest a feature of the present invention that attaches an additional overhead to a client signal to which time division multiplexing is applied, that is, to add another overhead separate from an overhead contained in the client signal. In this connection, the passage on page 141, left column, second paragraph, of *Doshi et al.* referenced in the Office Action explains that capacity scaling is achieved by increasing the rate of transmission. This feature does not appear to be related to claimed features of the invention.

It will be appreciated that, according to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(b) only if each and every claim element is found, either expressly or inherently described, in a single prior art reference.¹ The aforementioned reasons clearly indicate the contrary, and withdrawal of the 35 U.S.C. § 102(b) rejection based on *Doshi et al.* is respectfully urged.

Claims Not Rejected Based on Prior Art

Claims 17 – 21, 23 – 28, 30, 31, and 35, were not rejected based on prior art. Having been amended to overcome the 35 U.S.C. 112, first paragraph rejection, it is assumed that these claims are now in condition for allowance.

Conclusion

In view of the preceding discussion, Applicants respectfully urge that the claims of the present application define patentable subject matter and should be passed to allowance. Such allowance is respectfully solicited.

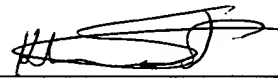
If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney at the number below.

¹ Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Please charge any additional required fee, including those necessary to obtain extensions of time to render timely the filing of the instant Reply, or credit any overpayment not otherwise paid or credited, to our deposit account No. 50-1698.

Respectfully submitted,
THELEN REID & PRIEST, L.L.P.

Dated: 8/9/04



Khaled Shami
Reg. No. 38,745

Thelen Reid & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640
Tel. (408) 282-1855
Fax. (408) 287-8040